

DOCKET NO. 2002.04.003.WS0
U.S. SERIAL NO. 10/080,889
PATENT

REMARKS

Claims 1-30 were originally filed in the present application.

Claims 1-30 are pending in the present application.

Claims 1-30 were finally rejected in the May 17, 2006 Office Action.

No claims have been allowed.

No claims are amendeded herein

Claims 1-30 remain in the present application.

Reconsideration of Claims 1-30 is respectfully requested in view of the following arguments, which the Applicants make in order to more particularly define the issues for appeal.

In Section 3 of the January 26, 2006 Office Action, the Examiner rejected Claims 1, 3, 6, 8, 16, 18, 21 and 23 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,471,471 to *Freeburg et al.* (hereafter, "*Freeburg*") in view of U.S. Patent No. 6,804,522 to *Lindskog et al.* (hereafter, "*Lindskog*"). In Section 4 of the January 26, 2006 Office Action, the Examiner rejected Claims 2, 7, 17 and 22 under 35 U.S.C. §103(a) as being unpatentable over the *Freeburg* reference in view of the *Lindskog* reference and further in view of U.S. Patent No. 6,112,088 to *Haartsen* (hereafter, "*Haartsen*"). In Section 5 of the January 26, 2006 Office Action, the Examiner rejected Claims 3, 8, 18 and 23 under 35 U.S.C. §103(a) as being unpatentable over the *Freeburg* reference in view of the *Lindskog* reference and further in view of U.S. Patent No. 6,141,566 to *Gerdisch et al.* (hereafter, "*Gerdisch*"). In Section 6 of the January 26, 2006 Office Action, the Examiner rejected Claims 4, 5, 9, 10, 19, 20, 24 and 25 under 35 U.S.C. §103(a) as being unpatentable over the

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Freeburg reference in view of the *Lindskog* reference and further in view of U.S. Patent Application Serial No. 10/034,234 (Pub. No. US2003/0123479) to *Lee et al.* (hereafter, "*Lee*"). In Section 7 of the January 26, 2006 Office Action, the Examiner rejected Claims 11-13 and 26-28 under 35 U.S.C. §103(a) as being unpatentable over the *Freeburg* reference in view of the *Lindskog* reference and further in view of the *Gerdisch* reference. In Section 8 of the January 26, 2006 Office Action, the Examiner rejected Claims 14, 15, 29 and 30 under 35 U.S.C. §103(a) as being unpatentable over the *Freeburg*, *Lindskog* and *Haartsen* references in view of the *Gerdisch* reference.

In rejecting Claim 1, the Examiner asserted that the *Freeburg* reference teaches an apparatus for use in a base transceiver station of a wireless communication system using a first standard within a coverage area and using a second standard within the coverage area, while acknowledging that the *Freeburg* reference does not teach a sectored antenna system for a coverage area and an omni antenna system for the coverage area. However, the Examiner asserted that the *Lindskog* reference teaches "using a sectored antenna system for wireless communications and an omni antenna system for wireless communications." The Examiner argued that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of the *Freeburg* and *Lindskog* references "to optimize performance and minimize interference of a cellular communication system."

To establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP § 2142, p. 2100-133 (8th

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ed. rev. 4, October 2005). In addition, there must be a reasonable expectation of success. *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *Id.*

The *Lindskog* reference describes benefits to be gained in a base station operating under a single standard from using both wide angle beam and narrow beam antennas. However, *Lindskog* includes no teaching of benefits obtained from utilizing a wide angle beam antenna with a first standard and a narrow beam antenna with a second standard. Furthermore, neither the *Freeburg* reference nor the *Lindskog* reference describes any shortcomings of the *Freeburg* method that would be overcome by the teachings of the *Lindskog* reference. As such, the Applicants respectfully submit that the motivation to combine the teachings of the *Freeburg* and *Lindskog* references comes, not from the references themselves or the knowledge generally available to one of ordinary skill in the art, but rather from the teachings of the Applicants' disclosure.

As noted, the *Lindskog* reference describes benefits to be gained from using both wide angle beam and narrow beam antennas in a base station operating under a single standard, but not in a base station operating under multiple standards. Thus, the *Lindskog* reference gives one of ordinary skill in the art no reasonable expectation of success in utilizing a wide angle beam antenna with a first standard and a narrow beam antenna with a second standard. The Applicants respectfully submit that the reasonable expectation of success in the combination proposed by the Examiner comes not from the prior art, but from the Applicants' disclosure.

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This being the case, Claim 1 recites unique and non-obvious limitations that are patentable over the *Freeburg*, *Lindskog*, *Haartsen*, *Gerdisch*, and *Lee* references. Furthermore, dependent Claims 2-5, which depend from Claim 1, contain all of the unique and non-obvious limitations that are recited in Claim 1. Therefore, dependent Claims 2-5 are also patentable over the *Freeburg*, *Lindskog*, *Haartsen*, *Gerdisch*, and *Lee* references.

The Applicants note that independent Claims 6, 11, 16, 21 and 26 recite limitations that are analogous to the unique and non-obvious limitations recited in Claim 1. Thus, independent Claims 6, 11, 16, 21 and 26 are patentable over the cited prior art references. Finally, dependent Claims 7-10, 12-15, 17-20, 22-25 and 27-30, which depend from independent Claims 6, 11, 16, 21 and 26, respectively, contain all of the unique and non-obvious limitations that are recited in their respective base claims. As such, dependent Claims 7-10, 12-15, 17-20, 22-25 and 27-30 are also patentable over the *Freeburg*, *Lindskog*, *Haartsen*, *Gerdisch*, and *Lee* references.

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SUMMARY

For the reasons given above, the Applicants respectfully request reconsideration and allowance of the pending claims and that this application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *jmockler@munckbutrus.com*.

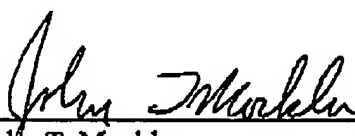
The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS, P.C.

Date: 17 July 2006

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